

The Examiner notes that claim 3 recites the limitation "the water phase" and contends that there is insufficient antecedent basis for this limitation in the claim. Claim 1 has been amended to clarify that the water and oil emulsion comprises a water phase and an oil phase in addition to the other ingredients mentioned in the claim. Support for this change is found on page 4, line 17 of the specification.

Claim 4 recites the limitation "the oil phase". The Examiner states that there is insufficient antecedent basis for this limitation in the claim. Applicants' amendment to claim 1, from which claim 4 depends, makes this rejection moot.

Claim 5 recites the limitation "the organic pigments". The Examiner contends that there is insufficient antecedent basis for this limitation in the claim and further suggests that Applicants be consistent in terminology and change "the organic pigments" to "the at least one organic pigment". Claim 5 has been amended accordingly.

Claim 6 is rejected for the same reason as claim 5. Applicants have amended claim 6 in accordance with the Examiner's suggestion.

The Examiner states that there is insufficient antecedent basis for the phrase "the surface" in claim 7. Claim 7 has been amended and the phrase "the surface" cancelled and replaced with "the eyes or skin". Claim 7 depends from claim 1 which contains the terms "eyes" and "skin", thus there is antecedent basis for those terms.

Claim 8 recites the limitation "the red pigment". The Examiner states that there is insufficient antecedent basis for this limitation in claim 5 from which this claim depends. Applicants have amended claim 8 to change the dependency to claim 6, which does provide antecedent basis for the phrase "the

red pigment". In response to the Examiner's statement that claim 8 recites the broad recitation of the red color as a D&C or FD&C color or Lake thereof, and that they are selected from monoazo, disazo, etc., Applicants have further amended claim 8 to delete reference to D&C and FD&C color and Lake thereof, as changing the dependency of the claim made this recitation redundant.

Claim 10 recites the limitation "the green pigment" but there is insufficient antecedent basis for this limitation in claim 5 from which claim 10 depends, the Examiner states. Claim 10 has been amended to change the dependency to claim 6. In addition the phrase "D&C and FD&C colors and Lakes thereof" has been deleted as changing the dependency in this manner made this recitation redundant.

Claim 12 recites the limitation "the blue pigment". The Examiner contends that there is insufficient antecedent basis for this limitation in claim 5 from which claim 12 depends. Claim 12 has been amended to change its dependency to claim 6. In addition the terms "D&C and FD&C color and Lake thereof" have been cancelled as changing the dependency made this recitation moot. This change is made in response to the Examiner's statement that the claim was vague and indefinite.

Claim 13 recites the limitation "the yellow pigment". The Examiner states that there is insufficient antecedent basis for this limitation in claim 5 from which claim 13 depends. Claim 13 has been amended to change the dependency to claim 6. In addition the terms "D&C color, FD&C color and Lakes thereof" has been cancelled from the claim as changing the dependency made these terms redundant, which addresses the Examiner's contention that the claim was also vague and indefinite.

The Examiner notes that claim 15 recites "the oil phase" and states that there is insufficient antecedent basis for this limitation in claim 1 from which claim 15 depends. Claim 1 was previously

amended to clarify that the emulsion composition has a water phase and an oil phase, thus providing antecedent basis for the term "oil phase" in claim 15.

Claims 21, 41, 58, and 76 are alleged to be vague and indefinite because it is unclear what constitutes an eyelash color, brow color, or lip color. The Examiner states that these terms are not defined in the specification and one skilled in the art would not reasonably be apprised of the scope of the claims.

Applicants respectfully disagree. The terms eyelash color, brow color, or lip color are very well known in the cosmetic art. The terms mean what they say. An eyelash color is a composition applied to the lashes to color them such as mascara. A brow color is a composition applied to eyebrows to provide color. A lip color is a cosmetic composition applied to the lips to provide color, e.g. lipstick. With respect to "lip color", that is also a well known term in the cosmetic art as is further evidenced by U.S. Patent No. 6,024,969 which is directed to cosmetic compositions formulated as supple doughs. Note in claim 21 of the '969 patent that the dough can be used in the form of a "lipcolor, foundation, blusher, or eyeshadow". Applicants have amended claim 21 to change to further define the "brow color" as a cosmetic composition for coloring eyebrows. Support for these changes is found on page 3, line 11 of the specification. In addition, Applicants searched the term "lash color" using the MSN search engine to determine how commonly the term is used and what it means. Enclosed are a number of printouts showing various commercially available products referred to as "lash color". It can be seen that this term has meaning to cosmetic consumers, otherwise manufacturers of such named products would not use that term. Accordingly, it is not understood how

one skilled in the cosmetic art, who has considerably more experience in this area than consumers do, would not understand what is meant by this term.

Claims 23, 42, 59, and 77 recite the limitation "the desired surface" however there is insufficient antecedent basis for this limitation in claim 1 from which claim 23 depends, the Examiner contends. Each of claims 23, 42, 59, and 77 have been amended to clarify that the desired surface is eyes or skin, and the plasticizer in the claimed composition is present in an amount sufficient to improve the spreadability and application of the composition when used to make up the eyes or skin. This corrects the antecedent basis discrepancy noted by the Examiner.

With respect to claims 27-29, 46-47, 63-65, and 80, they recite the limitation "the viscosity modifying agent", however the Examiner states that there is insufficient antecedent basis for that phrase in the claims. All of the claims have been amended to change the term "viscosity modifying agent" to "viscosity modifier", which makes all terms consistent. In response to the Examiner's statement that the metes and bounds of what constitutes "the viscosity modifying agent" is unclear, Applicants respectfully point out that they many pages of the specification are devoted to the description of the viscosity modifier, beginning on page 28, line 21 through page 30 line 5. The viscosity modifier is present for the purpose of increasing viscosity as is stated therein. Applicants have amended claims 26, 45, 62, 79, from which the other claims depend, to clarify this point.

Claims 33 and 50 recites the limitation of a "hydrophobic agent" however hydrophobicity is a relative term and therefore the metes and bounds of what constitutes a hydrophobic agent as claimed are unclear, the Examiner contends. Applicants respectfully disagree. First, claims 33 and 50 have been amended to clarify that the pigments referred to in these claims are coated with silicone, lecithin,

mineral oil, amino acids, or mixtures thereof. Support for this change is found on beginning on page 9, line 15 through page 10, line 15 of the specification.

Claim 87 recites the limitation of the composition not containing any "organic gelling agents" however, an organic gelling agent is not clearly defined by the claims or specification, the Examiner alleges, thus one skilled in the art would not be apprised of the scope of the claims without knowing the metes and bounds of what constitutes an organic gelling agent. Claim 87 specifies a composition which is free of "solid non-polymeric organic gelling agents". The specification defines the term "solid non-polymeric organic gelling agent" in great depth and detail beginning on page 5, line 11 and extending through page 6, line 4. It is stated on page 5, line 13 that the term "solid" means that the gelling agent is a solid at room temperature. On page 5, line 13 it is stated that the term "gelling agent" means that the ingredient is included in the composition for the purpose of gelling or increasing the viscosity of the composition from a liquid state to a less liquid, or even solid state. Continuing on page 5, the term is even further defined. It is Applicants' position that after one skilled in the art read the specification there would be absolutely no doubt as to what was meant by the phrase "free of solid non-polymeric organic gelling agents".

The Examiner is respectfully requested to reconsider the rejection of the claims under 35 USC 112 in view of the amendments and arguments presented herein.

The Rejection Under 35 USC 103

I. THE REJECTION OF CLAIMS 1-17, 21, 26-33, 35-37, 41, 45-50, 52-54, 58, 62-68, 70-72, 76, and 79-85 OVER McDERMOTT.

Claims 1-17, 21, 26-33, 35-37, 41, 45-50, 52-54, 58, 62-68, 70-72, 76, and 79-85 are rejected under 35 USC 103(a) as unpatentable over McDermott. The Examiner concludes that it would have

been obvious to one having ordinary skill in the art at the time the invention was made to have modified the organic and inorganic pigments by surface treating them to make them soluble in either a hydrophobic or hydrophilic environment because of the reasonable expectation that the surface coating of the pigments would produce pigments which could be solubilized in the desired environment. In addition, the Examiner states that McDermott teaches water in oil and oil in water emulsions and it would have been obvious to substitute one pigment color for another because of the expectation of successfully obtaining an emulsion composition with a desired color.

Applicants respectfully disagree with the Examiner's conclusion. First, it may be helpful to discuss the present invention and the problem it was intended to solve. One of the major need gaps in cosmetic compositions, particularly those applied to the eyes like mascara, is the desire for a deep, rich, natural tone to the cosmetic. At the same time, the most desirable cosmetics exhibit extended wear. Organic pigments provide excellent color tones but due to their water solubility it is difficult to formulate them into long wearing cosmetics because if the cosmetic user comes into contact with water such as perspiration or raindrops the pigments readily dissolve and tend to run onto the skin and hair.

It was discovered that organic pigments are readily usable in emulsion compositions like those described herein if the various pigments found in the claimed compositions are dispersed in the manner noted. Even further, if certain other ingredients are omitted or included, as defined in the claims, the compositions will exhibit the desired long wear properties. With that in mind, Applicants respond to the Examiner's rejections of the claims in groups corresponding to the various types of compositions that are claimed.

CLAIMS 1-29 : COMPOSITIONS CONTAINING ORGANIC PIGMENTS THAT ARE FREE OF INORGANIC PIGMENTS

1-17, 21, 26-29

Amended Claim 1 reads as follows (emphasis supplied):

A water and oil emulsion containing a water phase and an oil phase, at least one film forming polymer, and at least one organic pigment forming the main color component of the composition, wherein said composition *is free of inorganic pigments.*

Claims 2-29 depend on claim 1 and further define the various other parameters of the claim 1 composition.

There is simply nothing in McDermott that teaches or suggests compositions that are *free of inorganic pigments.* In column 6, lines 1-45, McDermott laundry lists the wide variety of pigments that may be used in his claimed compositions. They include organic pigments, inorganic pigments, pearlescent pigments, and surface treated versions of such pigments. No where does McDermott teach that his compositions should be free of inorganic pigments—in fact just the opposite. Not only does McDermott teach that the composition can contain wide variety of pigments of all types, but the Examples I-V illustrate water-in-oil emulsion mascara compositions that contain black iron oxide in large amounts. Accordingly, it is Applicants' position that McDermott teaches away from the composition of claims 1-17 by specifying that a wide variety of pigments are suitable for use in his claimed compositions, and depicting those containing only inorganic pigments in the examples. This is exactly opposite of the invention described in Applicants' claims 1-17.

Claim 21 depends on claim 1, and for the reasons discussed above, it is Applicants' position that McDermott teaches away from the invention in this claim. This claim further specifies that the composition of claim 1 may be an eyelash color, eyeliner, brow color, facial or body tattoo, or lipcolor.

McDermott teaches only eyelash color, and even then it is eyelash color that contains appreciable levels of inorganic pigment.

Claims 26-29 also depend on claim 1, and for the reasons discussed above, it is Applicants' position that McDermott teaches away from these claims as well. There is simply nothing in this reference that teaches or suggests compositions having the limitations of claims 26-29 and further, being free of inorganic pigments.

CLAIMS 30-47 : COMPOSITIONS CONTAINING INORGANIC AND ORGANIC PIGMENTS DISPERSED IN THE OIL PHASE OF THE EMULSION WHERE THE ORGANIC PIGMENT FORMS THE MAIN COLOR COMPONENT OF THE COMPOSITION

Claim 30 reads as follows:

A water and oil emulsion composition for making up the eyes or skin comprised of a water phase and an oil phase, at least one film forming polymer, at least one organic pigment, and at least one inorganic pigment, wherein at least one organic pigment and at least one inorganic pigment are dispersed in the oil phase and the organic pigment forms the main color component of the composition.

Claims 31-47 depend on claim 30 and further define the more preferred embodiments of the composition. Claims 31 and 32 specifically, define the organic pigments that may be present, and claim 33 the type of inorganic pigments that may be present.

As previously discussed, McDermott teaches a composition for application to the eyes where the pigment may be selected from a wide variety of organic, inorganic, or surface treated

pigments. The formulas of McDermott's Examples contain only inorganic pigments – black iron oxide specifically. In no case does McDermott teach or suggest that organic pigments should be present as the main color component of the composition. McDermott is nothing more than a general disclosure that various types of inorganic and organic pigments can be used in emulsion mascara compositions. There is simply no teaching or suggestion that the McDermott compositions be modified such that they contain both inorganic and organic pigments and that both types of pigments must be dispersed in the oil phase, or even further that the organic pigments present should form the main color component of the composition.

Claim 35 depends on claim 30, and is directed to a water and oil emulsion where the film forming polymer is soluble or dispersible in the water phase, and the composition contains at least one inorganic pigment and at least one organic pigment, both of which are dispersed in the oil phase. McDermott's composition contains a film forming polymer insoluble in the aqueous phase and dispersed therein, but the pigments used are not specified. As previously discussed they may be selected from a wide variety of inorganic and organic pigments. The McDermott compositions set forth in Examples I-V use a standard inorganic pigment, which is black iron oxide. There is simply nothing in McDermott that teaches or suggests the composition of claim 31 where organic pigments form the main color component of the composition.

Claim 41 is also rejected over McDermott. Claim 41 depends on claim 30 and, as amended, further specifies that the composition of claim 30 may be a lash color, eyeliner, cosmetic composition for coloring eyebrows, a facial or body tattoo, or a lip color. For the reasons

discussed above, Claim 30 is not obvious over McDermott. Accordingly Claim 41, which depends thereon, is not obvious.

Claim 45 depends on claim 30 and, as amended, specifies that the claim 30 composition further contains one or more viscosity modifiers, which increase the viscosity of the composition.

There is nothing in McDermott that teaches or suggests the composition of claim 45, which is a water and oil emulsion composition comprised of a water phase and an oil phase, at least one film forming polymer, at least one organic pigment and at least one inorganic pigment, wherein both types of pigment are dispersed in the oil phase, and where the composition further contains at least one viscosity modifying agent and the organic pigment present forms the main color component of the composition. While McDermott contains a film forming polymer, there is simply no mention of both inorganic and organic pigments being dispersed in the oil phase of the composition. McDermott's examples show only compositions that contain black iron oxide, which is apparently dispersed in the water phase of his oil in water emulsions.

Claims 46 and 47 depend on claim 45 and further define the type of viscosity modifier. For the same reasons, those claims are not obvious over McDermott.

CLAIMS 48-65: COMPOSITIONS CONTAINING ORGANIC PIGMENTS AND INORGANIC PIGMENTS WITH ORGANIC PIGMENT SOLUBILIZED IN WATER PHASE AND THE INORGANIC PIGMENT DISPERSED IN THE OIL PHASE AND THE ORGANIC PIGMENT FORMS THE MAIN COLOR COMPONENT OF THE COMPOSITION

Claim 48 is directed to another type of water and oil emulsion, and is set forth below:

A water and oil emulsion composition for making up the eyes or skin comprised of a water phase

and an oil phase, at least one film forming polymer, at least one organic pigment, and at least one inorganic pigment, wherein at least one organic pigment is solubilized in the water phase and at least one inorganic pigment is dispersed in the oil phase, and said organic pigment comprises the main color component of the composition.

Claims 49-65 depend on claim 48 and further define more preferred embodiments of the composition.

The composition of claim 48 has many limitations, among them: (1) a water and oil emulsion for making up eyes and skin, (2) at least one film forming polymer, (3) at least one organic pigment solubilized in the water phase, (4) at least one inorganic pigment dispersed in the oil phase, and (5) wherein the organic pigment present forms the main color component of the composition.

There is nothing in McDermott that teaches or suggests this specific type of composition. While McDermott teaches emulsion compositions containing a film forming polymer, there is no teaching of a composition containing both organic and inorganic pigments and where the organic pigment is solubilized in the water phase and the inorganic pigment dispersed in the oil phase and that the one or more organic pigments present form the main color component of the composition. Moreover, there is simply no way that it can be said that McDermott teaches or suggests a composition where *the organic pigments form the main color component of the composition*. McDermott laundry lists a wide variety of suitable pigments for use in his formulas, but there is no teaching or suggestion that organic pigments must be present at all, and if so must

be solubilized in the water phase of the composition, or that the inorganic pigments be dispersed in the oil phase. Since McDermott's examples are directed only to compositions containing appreciable levels of iron oxide it clearly cannot be said that this reference teaches that organic pigments, which are not even present, should form *the main color component of the composition*.

Claims 49 and 50 depend on claim 48 and further define the pigments. For the same reasons as discussed with respect to claim 48, claims 49 and 50 are not obvious.

Claims 52 and 53 further define the composition of claim 48. Claim 52 is directed to the composition of claim 48 wherein the film forming polymer is soluble or dispersible in the water phase of the claim 48 composition. The limitations of claim 52 are: (1) a water and oil emulsion for making up eyes and skin, (2) at least one film forming polymer, (3) film forming polymer soluble or dispersible in the water phase of the emulsion, (4) at least one organic pigment solubilized in the water phase, (5) at least one inorganic pigment dispersed in the oil phase, and wherein (6) the organic pigment forms the main color component of the composition.

McDermott teaches water and oil emulsion mascara compositions containing an insoluble film forming polymer, a nonionic surfactant, and pigments. McDermott teaches a wide variety of pigments may be used in the mascara composition, but exemplifies only compositions containing the standard black iron oxide. If one were to have the benefit of hindsight and use Applicants' patent application as a guide, one could probably pick and choose from the McDermott teachings to arrive at the composition of claim 52. However, hindsight reconstruction is not permitted. One skilled in the art must review the teachings of McDermott only, and within the four corners of the reference there must be some teaching or suggestion that there is an advantage to be

derived from selecting the specific limitations of Applicants' claim from McDermott to arrive at the claimed composition. It is Applicants' position that McDermott provides no such teaching or suggestion to select the specific limitations of claim 52 from the encyclopedic disclosure, and combine them to arrive at the composition of claim 52. Many substitutions would have to be made to arrive at the claimed compositions from McDermott, none of which are disclosed or suggested within the four corners of the reference. Particularly not disclosed or suggested are compositions where the organic pigments form the main color component of the composition.

Claim 53 depends on claim 48 and further defines a composition where the oil phase contains one or more volatile components. Claim 54, which depends on claim 53 further specifies these volatile ingredients as silicones or hydrocarbons. It is Applicants' position that it is only with the benefit of hindsight, using Applicants' specification as a guide, that one skilled in the art could reconstruct the composition of claims 53 and 54 using McDermott. There is simply nothing in the four corners of the reference itself that would suggest to the skilled artisan to select the limitations of those claims from McDermott and arrive at the claimed composition.

Claim 58 is directed to the composition of claim 48 which is selected from the group consisting of eyelash color, eyeliner, cosmetic composition for coloring eyebrows, facial or body tattoo, or lip color. McDermott teaches only eyelash color or mascara, but not the rest of the cosmetic compositions specified in claim 58. Further, there is nothing within the four corners of McDermott that would suggest any advantage to be derived from picking and choosing from this reference to arrive at a composition containing the limitations of claim 58.

Claims 62-65 depend on claim 58 and further specify that the composition contains viscosity modifiers, and what those viscosity modifiers are. When further combining those limitations with the limitations in claim 58, the resulting composition is not suggested by McDermott's teachings for the reasons set forth above.

CLAIMS 66-80: COMPOSITIONS CONTAINING ORGANIC PIGMENTS AND INORGANIC PIGMENTS WHERE THE ORGANIC PIGMENT IS DISPERSED IN THE OIL PHASE AND THE INORGANIC PIGMENT IN THE WATER PHASE AND THE ORGANIC PIGMENT COMPRISSES THE MAIN COLOR COMPONENT OF THE COMPOSITION

Claim 66 reads as follows:

A water and oil emulsion containing a water phase, an oil phase, and at least one film forming polymer, at least one organic pigment and at least one inorganic pigment wherein the at least one organic pigment is dispersed in the oil phase and at least one inorganic pigment is solubilized in the water phase, and the organic pigment comprises the main color component of the composition.

Claims 67-80 depend on claim 66. Claims 67 and 68 in particular further define the types of colors that are present, e.g. D&C or FD&C colors or Lakes thereof.

When one looks at the many limitations of claim 66, the only way one skilled in the art would be able to arrive at such a composition would be to use Applicants' specification as a guide and then pick and choose the appropriate ingredients from McDermott. There is nothing in McDermott that teaches or suggests the composition of claim 66. McDermott teaches away, if anything. While McDermott teaches that a wide variety of pigments, the exemplified

compositions contain only inorganic black iron oxide. Thus, McDermott cannot be said to suggest some advantage to arriving at Applicants' specific claimed composition where the *main color component* of the composition comprises organic pigments. Similarly, claims 66 and 67, which depend from claim 66 are not obvious for this reason. Moreover, when McDermott describes how his compositions are made in Column 7, lines 13-53, it is clear that the inorganic pigments present form part of the oil phase of the composition. Column 7, lines 13-20 state that the *waxes and fats are placed in a vessel equipped with heating and mixing. The waxes and fats are heated to about 85° C. with low speak mixing until liquified and homogeneous. At 85-90° C., pigments are uniformly dispersed through the lipid mixture....*" Similarly, the procedure for preparation of the mascaras in the water in oil emulsion form set forth in Column 7, lines 44-47, states that the "*components of phase A (petroleum distillates, quaternium-18 hectorite, and black iron oxide) are premixed for 30 minutes at room temperature with high shear. The phase A premix is then heated to 85-90° C. with high shear. The wax phase B ingredients are premixed and heated to 90° C. with slow stirring or one hour. The wax phase is added to the Phase A premix...*" It is quite clear from this description that the inorganic pigments present in McDermott are clearly dispersed in the oil phase of the composition. Accordingly, this reference also teaches away from Applicants' claim in another important respect.

Claim 70 further defines the film forming polymer as one that is soluble or dispersible in the water phase. Claims 71 and 72 further specify that the composition contains volatile components, and what they are.

It is Applicants' position that one could arrive at the compositions set forth in those claims only by using hindsight reconstruction using McDermott as a guide.

Claim 76 further defines the types of cosmetic compositions and depends on previous claim 75 which identifies the film forming polymer as a silicone acrylate copolymer. McDermott particularly does not teach that the film formers present are copolymers of silicone and ethylenically unsaturated monomers. McDermott teaches that the film forming polymers are aromatic vinyls, dienes, vinyl esters, olefins, unsaturated carboxylic acids, amides, etc. McDermott teaches that it is these types of polymers that contribute to the desired effects of his claimed composition. Accordingly, how can it be said that McDermott suggests the use of polymers that are completely different in chemical character in that they contain silicone moieties.

Claims 79-80 further define the composition of claim 76. For the same reasons as discussed with respect to claim 66, claims 79 and 80 are not obvious over McDermott.

CLAIMS 81-85: COMPOSITIONS CONTAINING ORGANIC PIGMENTS AND INORGANIC PIGMENTS WHERE BOTH ARE SOLUBILIZED IN THE WATER PHASE AND THE ORGANIC PIGMENT COMPRISSES THE MAIN COLOR COMPONENT OF THE INVENTION.

Claim 81 is directed to:

A water and oil emulsion composition for making up the eyes or skin comprised of a water phase and an oil phase, at least one film forming polymer, at least one organic pigment, and at least one inorganic pigment, wherein at least one organic pigment is solubilized in the water phase and at least one inorganic pigment is solubilized in the water phase and said organic pigment comprises the main color component of the composition.

There is nothing in McDermott that teaches or suggests the compositions described in these claims. Again, it is only by using hindsight and Applicants' application as a guide, that one skilled in the art could arrive at the compositions set forth in these claims. The McDermott compositions are traditional mascaras. McDermott teaches that such compositions may contain a wide variety of pigments but exemplifies only compositions containing appreciable levels of inorganic pigment. No mention is made of which phases these pigments must be solubilized or dispersed in. Most notably, McDermott does not teach that organic pigments should be present and should form the main color component of the composition. In fact, McDermott teaches away from such a situation by showing examples where the compositions contain nothing but inorganic pigments. Further, McDermott disperses the inorganic pigments present in his composition in the oil phase. In Applicants' claims 81-85, the pigments present are in the water phase, in direct contradiction to McDermott's teachings. Furthermore, there is nothing in this reference that states that the organic pigments present form the main color component of the composition.

Claims 82-85 depend on claim 81 and further define the oil phase components and ingredients of the base claim and are not obvious for the same reason.

CLAIMS 86-87: COMPOSITIONS CONTAINING ORGANIC PIGMENT WHICH ARE FREE OF SYNTHETIC AND NATURAL WAXES
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Claim 86 is directed to:

A water and oil emulsion comprising a water phase, and oil phase, at least one film forming polymer, and at least one organic pigment forming the main color component of the composition, where the composition *does not contain any synthetic or natural waxes.*

Claim 87 depends on claim 86 and further specifies that the composition of claim 86 does not contain any solid non-polymeric, organic gelling agents.

McDermott teaches compositions that contain both of these ingredients (see Column 5, lines 38+). Waxes and ingredients that qualify as solid non-polymeric gelling agents are critical components of the McDermott composition. Thus it cannot be said that this reference makes it obvious to make compositions that are "free of" such agents. McDermott teaches away from the claims by specifying compositions that contain appreciable levels of the ingredients which Applicants' claims are free of.

It is Applicants' position that the pending claims are patentable over McDermott for the reasons discussed herein. The Examiner is respectfully requested to reconsider this rejection.

II. THE REJECTION OF CLAIM 1-87 OVER MCDERMOTT IN VIEW OF ALWATTARI AND KRYZIK

Claims 1-87 are rejected under 35 USC 103(a) as unpatentable over McDermott in view of Alwattari (U.S. 5,985,258) and Krzysik (U.S. 5,512,272). The Examiner first summarizes the teachings of McDermott, and states that this reference does not teach a silicone film forming polymer, the pigment colors and the plasticizer of claims 9-12, 14, 18-20, 23-25, 30, 34, 38-40, 42-44, 48, 51, 55-57, 59-61, 66, 69, 73-75, 77-78, 81, and 86, and the absence of the solid non-polymeric organic gelling agents of claim 87.

The Examiner then cites Alwattari, contending that this reference teaches mascaras containing both water soluble and water insoluble film forming polymers, alkyl methicone waxes, and inorganic and organic pigments.

The Examiner contends the Krzysik teaches cosmetic compositions containing an aqueous latex of crosslinked polyorganosiloxane (or silicone elastomer).

The Examiner concludes that it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the mascara formulation of McDermott by adding plasticizers and water soluble and water insoluble polymers as taught by Alwattari and the silicone acrylates as taught by Krzysik because of the reasonable expectation of obtaining a mascara composition with enhanced durability which contains film forming polymers in both the water and oil phases.

Applicants respectfully disagree.

The teachings of McDermott are set forth above. Alwattari teaches mascara compositions that are in the emulsion form and contain both a water soluble film forming polymer and a water insoluble film forming polymer. Alwattari teaches that the water insoluble film forming polymer is present as a dispersion in water, i.e. the water phase of Alwattari's emulsion. The water soluble film forming polymer is also present in the water phase of the Alwattari composition. Alwattari further teaches that the composition contains oils or fats, emulsifiers, and waxes. Alwattari also teaches that a wide variety of organic and inorganic pigments may be incorporated into his emulsion compositions but exemplifies use of inorganic pigments only. Further, as in McDermott, it appears that the pigments present are dispersed in the oil phase of the emulsion mascara

composition as set forth in the processing instructions set forth on Column 6, beginning at line 63 through Column 7, line 37.

Krzysik teaches skin care compositions containing a certain type of silicone elastomer.

The elastomer is made by reacting a silicone of the formula:



where R is methyl, ethyl, propyl, phenyl, vinyl, allyl, and 3,3,3-trifluoropropyl; and x is 3 to 100;

with a second silicone of the formula:



where R' is a monovalent hydrocarbon radical having up to 12 carbons, and R³ is an alkyl having one to six carbon atoms, and a is 0-1.

Applicants respectfully disagree with the Examiner's conclusion that Krzysik teaches silicone acrylate copolymers. As is evident from the above, Krzysik's polymers are silicones, which may have hydrocarbon functional groups attached in some cases. However, there are no acrylate moieties present on Krzysik's polymers so they cannot, by any stretch of the imagination, be called silicone acrylate copolymers.

Kryzsik teaches that his elastomers can be used in mascara compositions and illustrates such a composition in Table I. It appears to be an emulsion, contains iron oxide (inorganic pigment) and ultramarine blue (inorganic pigment), waxes, and the silicone elastomer in aqueous dispersion. Kryzsik teaches that the pigments present in the composition are incorporated into the aqueous phase of the composition, as set forth in Column 3, lines 53+.

The teachings of these references will be discussed in connection with groups of claims.

CLAIMS 1–29 : COMPOSITIONS THAT ARE FREE OF INORGANIC PIGMENTS

Amended Claim 1 reads as follows (emphasis supplied):

A water and oil emulsion containing a water phase and an oil phase, at least one film forming polymer, and at least one organic pigment forming the main color component of the composition, wherein said composition *is free of inorganic pigments.*

The claim is specifically directed to a composition in the emulsion form containing at least one film forming polymer and at least one organic pigment, wherein said composition is free of inorganic pigments.

McDermott teaches an emulsion mascara containing a film forming polymer in the aqueous phase. McDermott teaches that his compositions may contain an encyclopedic list of pigments including organic, inorganic, and so on. McDermott exemplifies a composition that contains a substantial amount of inorganic black iron oxide.

Alwattari teaches an emulsion mascara containing two film forming polymers in the aqueous phase. One polymer is water soluble, one water insoluble. Alwattari further teaches that the composition may contain a wide variety of pigments, including inorganic and organic. Alwattari's examples are of mascara compositions containing significant amounts of inorganic pigment and no organic pigment.

Kryzsik teaches emulsion mascara compositions containing silicone elastomers. The mascara composition in Kryzsik's example contains only inorganic pigments (ultramarine blue and black iron oxide). Further, when Kryzsik describes how the compositions are made in Column 3,

beginning at line 57 through Column 4, line 50, it is clear that inorganic pigments present are found in the water phase of Kryzsik's emulsion composition.

None of these references teach a composition that is, specifically, free of inorganic pigment. In fact all of the references teach that inorganic pigments appear to be essential to the claimed composition by providing examples that contain only inorganic pigments in substantial amounts, and completely lack organic pigments. Further, by placing all pigments as equivalent with respect to their possible use in the reference compositions – pick one, pick the other, it doesn't matter – the references teach away from preparing compositions that are specifically free of inorganic pigments. There is simply nothing in McDermott, Alwattari, or Kryzsik either alone or in combination that suggests any advantage to be derived from preparing an emulsion composition as set forth in Applicants' claim 1 that is *free of inorganic pigments*. Claims 2-29, which depend from claim 1 and further specify the other ingredients that may be present, are accordingly not obvious for this reason. With respect to claims 1-29, a composition that contains solely organic pigments provides more intense, natural color when compared to compositions that contain only inorganic pigments.

It is Applicants' position that the references combined, at most, teach away from the invention of claims 1-29, which are free of inorganic pigments.

CLAIMS 30-47 : COMPOSITIONS CONTAINING INORGANIC AND ORGANIC PIGMENTS DISPERSED IN THE OIL PHASE OF THE EMULSION WHERE THE ORGANIC PIGMENT FORMS THE MAIN COLOR COMPONENT OF THE COMPOSITION

Claim 30 reads as follows:

A water and oil emulsion composition for making up the eyes or skin comprised of a water phase and an oil phase, at least one film forming polymer, at least one organic pigment, and at least one inorganic pigment, wherein at least one organic pigment and at least one inorganic pigment are dispersed in the oil phase and the organic pigment forms the main color component of the composition.

The composition of claim 30 is directed to an emulsion having at least one film forming polymer and a combination of an inorganic and organic pigment, both of which are dispersed in the oil phase of the composition. Moreover, the organic pigment that is present must form the main color component of the composition. Both McDermott and Alwattari teach mascara compositions in the emulsion form that may contain a wide variety of pigments. The examples in both patents show formulas containing only inorganic pigment –black iron oxide--. No where does either reference teach or suggest that the mascara compositions should contain organic pigments that form the main color component of the composition. Further, both references would appear to teach away from such a thing by emphasizing the importance of inorganic pigments and showing only examples that contain such. Krzysik teaches mascara compositions containing inorganic pigments including black iron oxide and ultramarine blue in appreciable amount (10% by weight). Both of the inorganic pigments exemplified in this reference are found in the water phase as described by Krzysik when he summarizes the method by which such compositions were manufactured. The incorporation of the Krzysik pigments into the water phase is in direct contradiction to the specifications of claim 30.

It is Applicants' position that none of the references either alone or in combination teaches or suggests the invention of claim 30.

Similarly, the claims that depend on claim 30 further define the more preferred components of claim 30 and further describe preferred ingredients found therein. Such claims are not obvious for the same reasons set forth with respect to claim 30.

CLAIMS 48-65: COMPOSITIONS CONTAINING ORGANIC PIGMENTS AND INORGANIC PIGMENTS WITH ORGANIC PIGMENT SOLUBILIZED IN WATER PHASE AND THE INORGANIC PIGMENT DISPERSED IN THE OIL PHASE AND THE ORGANIC PIGMENT FORMS THE MAIN COLOR COMPONENT OF THE COMPOSITION

Claim 48 is directed to another type of water and oil emulsion, and is set forth below:

A water and oil emulsion composition for making up the eyes or skin comprised of a water phase and an oil phase, at least one film forming polymer, at least one organic pigment, and at least one inorganic pigment, wherein at least one organic pigment is solubilized in the water phase and at least one inorganic pigment is dispersed in the oil phase, and said organic pigment comprises the main color component of the composition.

The teachings of McDermott, Alwattari, and Krzysik are set forth above. In no case do these references teach compositions where the organic pigment forms the main color component of the composition. In fact, in McDermott, Alwattari, and Krzysik the inorganic pigments for the main color component of the composition, as they are the only pigments present in the compositions exemplified.

Further, the pigments in McDermott and Alwattari form part of the oil phase of the composition, and in Krzysik the pigments present are incorporated into the water phase. There is simply nothing in the references either alone or in combination that teaches or suggests that the composition should contain both inorganic and organic pigments and the inorganic pigments present should be dispersed in the oil phase and the organic pigments in the water phase. For this reason, claim 48 is not obvious over the combination of references, nor are the claims that depend thereon.

CLAIMS 66-80: COMPOSITIONS CONTAINING ORGANIC PIGMENTS AND INORGANIC PIGMENTS WHERE THE ORGANIC PIGMENT IS DISPERSED IN THE OIL PHASE AND THE INORGANIC PIGMENT IN THE WATER PHASE AND THE ORGANIC PIGMENT COMPRISSES THE MAIN COLOR COMPONENT OF THE COMPOSITION

Claim 66 reads as follows:

A water and oil emulsion containing a water phase, an oil phase, and at least one film forming polymer, at least one organic pigment and at least one inorganic pigment wherein the at least one organic pigment is dispersed in the oil phase and at least one inorganic pigment is solubilized in the water phase, and the organic pigment comprises the main color component of the composition.

The McDermott and Alwattari compositions teach that the pigments present must be dispersed in the oil phase. The Krzysik patent teaches that the pigments are incorporated into the water phase. There is simply nothing in these references alone or combined that teaches or suggests that the at least one organic pigment present is dispersed in the oil phase and the at least one inorganic pigment present

be solubilized in the water phase. Further, there is simply no teaching that in any of the McDermott, Alwattari, or Krzysik compositions that the organic pigment present forms the main color component of the composition. Claims 67-80, which depend on claim 66 further specify the preferred ingredients in the claimed compositions. Since claim 66 is not obvious over the combined references, claims 67-80 are not obvious either for the same reasons.

CLAIMS 81-85: COMPOSITIONS CONTAINING ORGANIC PIGMENTS AND INORGANIC PIGMENTS WHERE BOTH ARE SOLUBILIZED IN THE WATER PHASE AND THE ORGANIC PIGMENT COMPRISSES THE MAIN COLOR COMPONENT OF THE INVENTION.

Claim 81 is directed to:

A water and oil emulsion composition for making up the eyes or skin comprised of a water phase and an oil phase, at least one film forming polymer, at least one organic pigment, and at least one inorganic pigment, wherein at least one organic pigment is solubilized in the water phase and at least one inorganic pigment is solubilized in the water phase and said organic pigment comprises the main color component of the composition.

McDermott, Alwattari, and Krzysik teach compositions where the pigments are dispersed in the oil phase. Moreover, none of the examples illustrate compositions containing organic pigments so it cannot be said that these references teach or suggest that organic pigments form the main color component of the composition.

Applicants' invention resides in compositions where the organic pigments present form the bulk, if not all of the color, in the composition. If inorganic pigments are present they are present in amounts that are minimal enough so that they do not exert a significant impact on the final color of the composition. The reason for this is to obtain the bright, natural, intense colors found with organic pigments. Incorporating too much inorganic pigment into such compositions mutes the color provided by the organic pigments and, in essence, defeats the purpose of the invention.

CLAIMS 86-87: COMPOSITIONS CONTAINING ORGANIC PIGMENT WHICH ARE FREE OF SYNTHETIC AND NATURAL WAXES

Claim 86 is directed to:

A water and oil emulsion comprising a water phase, and oil phase, at least one film forming polymer, and at least one organic pigment forming the main color component of the composition, where the composition *does not contain any synthetic or natural waxes*.

None of the compositions taught in McDermott, Alwattari, or Krzysik are free of natural or synthetic waxes. In fact such an omission is quite unusual in mascaras because that is how the viscosity of such compositions is provided—with waxes. It is Applicants' position that references that teach the use of natural and synthetic waxes in large amounts cannot make obvious compositions that are specifically free of those materials. Further, there is nothing in any of the references that teaches compositions where the organic pigment present forms the main color component of the composition.

Claim 87, which depends on claim 86, is not obvious for the same reasons.

It is Applicants' position that nothing in the references either alone or in combination teaches or suggests that any advantage would be derived from picking and choosing the specific items found in the references and combining them to arrive at the compositions set forth in claims 1-87. Many fortuitous substitutions would be necessary to arrive at the claimed compositions when considering the reference teachings. There is simply nothing within the four corners of the references themselves that suggests any advantage to so doing.

To further substantiate the patentability of the pending claims, one of the co-inventors of the captioned application, Jean Manelski, prepared pigment draw downs of the pigments disclosed in Krzysik's Table I, Composition B, which is a combination of 10 parts black iron oxide and 2 parts ultramarine blue. Also prepared for comparative purposes were draw downs of the composition further set forth below:

A	B	C	D
10:2 black iron oxide : ultramarine blue	12 black iron oxide	10:2 black iron oxide : FD&C Blue #1	12 FD&C Blue #1
muddy black, very slight blue tinge	muddy black	muddy black, very slight purple tinge	brilliant purple red

A photograph of the draw downs is enclosed with the Declaration of Jean Manelski submitted herewith. The draw downs show a number of things. First, when the organic pigment (FD&C blue #1) is present by itself (as in the claims directed to compositions *free of* inorganic pigments) the difference in the clarity and brilliance of the color could not be more evident. When black iron oxide is present by itself or in combination with small amounts of an organic pigment, the compositions are still muddy in appearance and do not exhibit the clarity and color brilliance that would be found in

compositions that are *free of* inorganic pigments or compositions that contain inorganic pigments but where the organic pigments *form the main color component of the composition*. As can be seen by viewing the photograph enclosed with the Manelski declaration, compositions A, B, and C are very muddy and nearly indistinguishable in appearance. Clearly, particularly in C, the organic pigment that is present does not form the main color component of the composition because the draw down is muddy black in color and is virtually indistinguishable from draw down B which comprises black iron oxide alone.

In addition, Manelski prepared compositions that contained organic and inorganic pigments in various proportions. Drawdowns of those compositions illustrate the considerable difference in color hue and intensity when the compositions contain organic pigments as the main color component of the composition. In particular, when organic pigments form the main color component of the composition, the resulting compositions exhibit a brilliant intense color. On the other hand, when inorganic pigments form the main color component of the composition, the compositions are muddy and nearly opaque in consistency.

It is Applicants' position that the pending claims are patentable over the amendments, arguments, and the supporting Declaration submitted herewith. The Examiner is most respectfully

requested to reconsider the patentability of the pending claims.

Respectfully Submitted,



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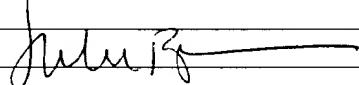
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MARKED UP COPY OF SPECIFICATION TO SHOW CHANGES MADE

Please amend the paragraph on page 9, lines 6-16 as follows:

In the event the claimed composition contains inorganic pigments, preferred is where the amount is sufficient to accentuate the color achieved with the organic pigment but not obscure the intensity of the organic pigments. Preferred ranges include about 0.001-15%, preferably about 0.005-10%, more preferably about 0.01-8% by weight of the total composition. Suitable inorganic pigments include iron oxides such as red, blue, black, green, and yellow; titanium dioxide, bismuth oxychloride, and the like. Preferred are iron oxides. Such inorganic pigments may be found in the water or oil phases depending on their solubilities. For example, iron oxides are usually water soluble and will migrate to the [oil] water phase. On the other hand, iron oxides treated with hydrophobic agents such as silicone, lecithin, mineral oil, or similar materials, will cause the pigment to be hydrophobic in nature and migrate to the oil phase of the composition.

MARKED UP COPY OF CLAIMS TO SHOW CHANGES MADE

1. **(Amended)** A water and oil emulsion composition for making up the eyes and skin comprising a water phase, an oil phase, at least one film forming polymer and at least one organic pigment forming the main color component of the composition, said composition being free of inorganic pigments.

5. **(Amended)** The composition of claim 1 wherein the at least one organic pigment[s are] is a D&C color[s], FD&C color[s], or Lakes of D&C or FD&C color[s].

6. **(Amended)** The composition of claim 5 wherein the at least one organic pigment[s are] is selected from the group consisting of red, green, blue, yellow, violet, orange, and mixtures thereof.

7. **(Amended)** The composition of claim 1 which provides a black or dark brown color to the [surface] eyes or skin to which it is applied, and said color is achieved by combining organic pigments selected from the group consisting of red, green, blue, yellow, violet, orange, and mixtures thereof.

8. **(Amended)** The composition of claim [5] 6 wherein the red pigment is [a D&C or FD&C color or Lake thereof] selected from the group consisting of monoazo, disazo, fluoran, xanthene, or indigoid pigment.

10. **(Amended)** The composition of claim [5] 6 wherein the green pigment is a [D&C or FD&C color or Lake thereof] selected from the group consisting of triphenylmethane, anthroquinone, or pyrene.

12. (Amended) The composition of claim [5] 6 wherein the blue pigment is [a D&C or FD&C color or Lake thereof which is] a triphenylmethane pigment.

13. (Amended) The composition of claim [5] 6 wherein the yellow pigment is [a D&C or FD&C color or Lake thereof] selected from the group consisting of pyrazole, monoazo, fluoran, xanthene, or quinoline.

21. (Amended) The composition of claim 1 which is an eyelash color, eyeliner, composition for coloring eyebrows [brow color], facial or body tattoo, or lipcolor. [.]

22. Cancel

23. (Amended) The composition of claim 1 further comprising a plasticizer in an amount sufficient to improve spreadability and application of the composition [to the desired surface] when used to make up the eyes or skin.

26. (Amended) The composition of claim 1 further comprising one or more viscosity modifiers which increase the viscosity of the composition.

27. (Amended) The composition of claim 26 wherein the viscosity [modifying agent] modifier is present at 0.01-60% by weight of the total composition.

28. (Amended) The composition of claim 27 wherein the viscosity [modifying agent] modifier is selected from the group consisting of natural or synthetic montmorillonite minerals, associative thickeners, silicas, or silicates.

29. (Amended) The composition of claim 28 wherein the viscosity [modifying agent] modifier is a natural or synthetic montmorillonite mineral reacted with a quaternary ammonium compound.

33. **(Amended)** The composition of claim 30 wherein the inorganic pigment is coated with [a hydrophobic agent] silicone, lecithin, mineral oil, amino acids, or mixtures thereof.

41. **(Amended)** The composition of claim 30 which is an eyelash color, eyeliner, cosmetic composition for coloring eyebrows [brow color], a facial or body tattoo, or a lip color.

42. **(Amended)** The composition of claim 30 further comprising a plasticizer in an amount sufficient to improve spreadability and application of the composition [to the desired surface] when used to make up the eyes or skin.

45. **(Amended)** The composition of claim 30 further comprising one or more viscosity modifiers which increase the viscosity of the composition.

46. **(Amended)** The composition of claim 45 wherein the viscosity [modifying agent] modifier is present at 0.01-60% by weight of the total composition and comprises natural or synthetic montmorillonite minerals, associative thickeners, silicas, or silicates.

47. **(Amended)** The composition of claim 46 wherein the viscosity [modifying agent] modifier is a natural or synthetic montmorillonite mineral reacted with a quaternary ammonium compound.

50. **(Amended)** The composition of claim 48 wherein the inorganic pigment is treated with [a hydrophobic agent] silicone, lecithin, mineral oil, amino acids or mixtures thereof.

58. **(Amended)** The composition of claim 48 which is an eyelash color, eyeliner, cosmetic composition for coloring eyebrows [brow color], facial or body tattoo composition, or lip color.

59. **(Amended)** The composition of claim 48 further comprising a plasticizer in an amount sufficient to improve spreadability and application of the composition [to the desired surface] when used to make up the eyes or skin.

62. (Amended) The composition of claim 48 further comprising one or more viscosity modifiers which increase the viscosity of the composition.

63. (Amended) The composition of claim 62 wherein the viscosity [modifying agent] modifier is present at 0.01-60% by weight of the total composition.

64. (Amended) The composition of claim 63 wherein the viscosity [modifying agent] modifier is selected from the group consisting of natural or synthetic montmorillonite minerals, associative thickeners, silicas, or silicates.

65. (Amended) The composition of claim 64 wherein the viscosity [modifying agent] modifier is a natural or synthetic montmorillonite mineral reacted with a quaternary ammonium compound.

76. (Amended) The composition of claim 75 which is an eyelash color, eyeliner, cosmetic composition for coloring eyebrows [brow color], facial or body tattoo composition, or lip color.

77. (Amended) The composition of claim 66 further comprising a plasticizer in an amount sufficient to improve spreadability and application of the composition [to the desired surface]when used to make up the eyes or skin.

79. (Amended) The composition of claim 66 further comprising one or more viscosity modifiers which increase the viscosity of the composition.

80. (Amended) The composition of claim 79 wherein the viscosity [modifying agent] modifier is present at 0.01-60% by weight of the total composition, and is a natural or synthetic montmorillonite mineral, associative thickener, silica, silicate, or mixtures thereof.